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1636

Attorney's Docket No.: 12279-002001

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Kim et al.

Art Unit : 1636

Serial No. : 09/785,632

Examiner : T. McKelvey

Filed : February 16, 2001

Title : ZINC FINGER DOMAINS AND METHODS OF IDENTIFYING SAME

RECEIVED

Commissioner for Patents

P.O. Box 1450

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Alexandria, VA 22313-1450

RESPONSE TO SECOND RESTRICTION REQUIREMENT

TECH CENTER 1600/2900

In the action dated September 26, 2003, the Examiner required three species elections. The Applicants traverse the requirements for the first and second species elections below.

1. The Applicants elect a method in which the hybrid nucleic acid is made by amplifying and joining. Claims 1-35 and 86-98 read on this species.
2. The Applicants elect a method in which the test zinc finger domain is identified in a sequence database and then made. Claims 1-35 and 86-98 read on this species.
3. The Applicants elect a method in which an activation domain is used. Claims 1-35, 86, 88-93, and 95-98 read on this species.

## CERTIFICATE OF MAILING BY FIRST CLASS MAIL

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37 C.F.R. 1.146 permits elections between “species of [the] invention to which [a] claim will be restricted if no claim to the genus is found allowable.” Without further clarification, the Examiner's asserted species – “simply provided” – does not appear to be a proper species of the invention. “Simply provided” and “amplifying and joining” have a genus-species relationship, since “amplifying and joining” is one method of “simply provid[ing]” the hybrid nucleic acids. The alternative interpretation is that “simply provided” means provided by a method other than “amplifying and joining” and that the Examiner finds that such a method is a disclosed species of the invention to which the claims could be restricted. The Applicants request clarification if the Examiner maintains this requirement for election.

Similarly, “simply provided” and “identified in a sequence database and then made” have a genus-species relationship, since identification in a sequence database is one method of “simply provid[ing]” a test zinc finger domain. Again, if “simply provided” means provided by a method other than “identified in a sequence database and then made,” then the Applicants understand that the Examiner finds that such a method is a disclosed species of the invention to which the claims could be restricted. The Applicants request clarification if the Examiner maintains this requirement for election.

The Examiner also stated that “claims 1 and 21 are generic.” Page 3 of the dated September 26, 2003. As noted above, claims 1-35 and 86-98 are generic with respect to the first and second species elected above. Further, claim 95 is generic with respect to independent claims 1, 16, and 26, and links Groups I and IV. Because the Examiner indicated that claims 1-35 and 86-119 are pending and did not further restrict these claims, the Applicants conclude that claims 1-35 and 86-119 will be examined in this application, subject only to the provisional species elections (of which two are traversed). Note that each of dependent claims 86-94 depends on either claim 1 or claim 21, so claims 86-94 are within Group I and should be examined with that group.

If further discussion is necessary prior to substantive examination, the Examiner is urged to call the undersigned at 617-542-5070.

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Respectfully submitted,

Date:

Oct. 27, 2003

Janis K. Fraser, Ph.D., J.D.

Reg. No. 34,819

Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110-2804  
Telephone: (617) 542-5070  
Facsimile: (617) 542-8906

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